Applicants respectfully traverse the Examiner's position. The claims of Group I are directed to an amylase and the claims of Group VI are directed to a DNA sequence encoding the amylase of the claims of Group I. Further, the claims of Group I directed to the amylase and the claims of Group II, directed to a method of making the amylase of Group I should also be examined together.

MPEP 803 recites that if "the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." Applicants contend that this is the situation in the present application because when the examiner performs a sequence search, both the amylase and the DNA encoding this amylase will be located simultaneously. Likewise, the search of the claims amylase will locate the claimed method of making the claimed amylase.

Pursuant to MPEP § 1850, in PCT national phase cases, (§371 cases) the Examiner is required to follow the determination of the International Bureau and cannot *sua sponte*, set forth his or her own groupings for purposes of examination. For example, *Caterpillar Tractor Co. v Commissioner of Patents*, 650 F.Supp. 218, 231 USPQ 590 (VA 1986).

The standards of restriction practice for PCT applications entering the national stage in the United States Patent & Trademark Office, as is the present application, are governed by 37 CFR §§ 1.475 and 1.499. The present application contains claims to all three categories of product, process of making and process of use, and pursuant to 37 CFR § 1.475 (b), an international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:...(3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product;..." This category applies to the present application, and in view of this patent rule, it is requested that claims 38-43 (Group II) directed to a process of producing an amylase of Group I (claims 25-37) be included with the claims of Group I and examined on the merits.

Applicants respectfully request that the Examiner reconsider his position regarding this restriction requirement and examine the claims of Groups I and II as one invention for the reasons set forth above. It is believed that the alleged separate inventions are related and should be examined as one invention.

Applicants, of course, reserve the right to file a divisional application covering the subject matter of the non-elected claims. Receipt of the initial Office Action on the merits is awaited.

Respectfully submitted,

May 20, 2002
Date

Stephen A. Bent
Reg. No. 29,768

FOLEY & LARDNER
3000 K Street, N.W., Suite 500
Washington, D.C. 20007-5109
Phone: (202) 672-5300
Fax: (202) 672-5399

THE COMMISSIONER IS HEREBY AUTHORIZED TO CHARGE ANY DEFICIENCY OR CREDIT ANY OVERPAYMENT TO DEPOSIT ACCOUNT NO. 19-0741.